OFFICIAL

#12
AB
4/7/03

Response under 37 CFR 1.116
Expedited Procedure
Examining Group 1746

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Gross et al.
Appl. No.	:	09/643,141
Filed	:	08/22/00
Title	:	GRAFFITI REMOVER, PAINT STRIPPER, DEGREASER
Grp./A.U.	:	1746
Examiner	:	S. Carrillo
Docket No.	:	M 6636 CC/CSAP

CERTIFICATE OF FACSIMILE TRANSMISSION PER 37 C.F.R. § 1.8

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

April 3, 2003 — Date
Marlene Capreri — Signature of certifier
Marlene Capreri — Typed or printed name of certifier

RESPONSE UNDER RULE 116

Assistant Commissioner for Patents
Box AF
Washington, DC 20231

Sir:

This is in response to the Office Action dated January 13, 2003, in the above-identified application.

Serial No.: 09/643,141
Art Unit: 1746

REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

Claims 33-50, 53 and 54 are pending in this application.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claim 46 remains rejected under 35 U.S.C. § 112, second paragraph. This rejection is again respectfully traversed for the following reasons.

As was stated by Applicant in its previous response, the plain meaning of the term "thermal stability", as it is understood by those skilled in the art, is obviously what is meant thereby. More particularly, the composition does not suffer any deleterious effects when exposed to temperatures spanning the claimed temperature range. Furthermore, since the objected-to term clearly refers to the "composition" in claim 46, it is obviously the "composition" that is thermally stable, not a specific component thereof. Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this objection is again respectfully requested.

Claims 33-34, 36-42 and 44-48 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Steven (US 6,172,031). This rejection is again respectfully traversed for the following reasons.

Applicant would again like to note that it is extremely well settled that a factual determination of anticipation requires the disclosure, in a single reference, of each and every element of the claimed invention, and an Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See, *In re Levy*, 17 USPQ2d 1561 (Bd. Pat. App. & Inter. 1990). As a result, Applicant once again respectfully submits that this reference fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

Serial N .: 09/643,141
Art Unit: 1746

Applicant had previously argued that the present invention requires that its composition be terpene-free. While the Stevens reference suggests that terpene need not be present in its composition, it fails to **require** its absence. Since this element of the claimed invention is not disclosed by Stevens, for this reason alone the reference should not anticipate the present invention.

The Examiner contends, however, that because Stevens **suggests** that its composition may be terpene free, that is sufficient to anticipate the claimed invention. The standard for anticipation, however, is not suggestion but rather, **disclosure**. See *In re Levy*, supra. Nowhere within the Stevens reference is a terpene free composition **disclosed**. As a result, Applicant submits that this reference should not serve to anticipate the present invention.

As for the limitations associated with claimed components (a) and (b), the Examiner relies upon the disclosure in Stevens at col. 4, lines 40-45, and col. 3, lines 20-22. In col. 4, lines 40-45, Stevens teaches the use of an oil-soluble surfactant as being merely optional, not mandatory as is presently claimed. While Applicant appreciates the Examiner's attempt at defining the term "optional" in a way which anticipates the claimed invention, such an exercise is believed to be impermissible. For example, where Stevens teaches that the presence of terpene in its composition is optional, see col. 3, lines 42-46, the Examiner interprets this as meaning terpene is NOT employed, thereby rendering this element of the claimed invention anticipated. Conversely, where Stevens teaches the presence of oil-soluble surfactants as being optional, see col. 4, line 40, the Examiner here interprets this as meaning they are in fact present in its composition. This type of self-serving interpretation should not form the basis for an anticipation rejection. As was mentioned previously, a determination of anticipation requires the **disclosure** of each and every element of the claimed invention, not the suggestion of its possible use. See, *In re Levy*, supra.

Serial No.: 09/643,141
Art Unit: 1746

This reference fails to disclose, at col. 4, lines 40-45, the claimed amounts of oil-soluble anionic surfactant and water-soluble anionic surfactants. Instead, this reference merely broadly teaches the amount of surfactant, **in general**, which may be present in its composition. Once again, Applicant would like to note that each and every element of a claimed invention must be disclosed within a prior art reference for it to anticipate said invention. A generic teaching relating to a range of surfactant which may be present in a composition fails to satisfy the burden of proof required to establish an invention's anticipation by a prior art reference.

Finally, this reference's teaching must be read in light of the fact that its composition is directed to cleaning **textiles**, whereas the claimed composition is intended to be used for cleaning hard surfaces. The amount and type of surfactants used in a textile cleaning composition typically differ from those employed in hard surface cleaning compositions.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 35 and 43 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevens (US 6,172,031). This rejection is again respectfully traversed for the following reasons.

With respect to claim 35, the Stevens reference admittedly fails to teach the use of the claimed isopropyl amine salt of dodecylbenzene sulfonic acid. In an effort to overcome this admitted lack of teaching, the Examiner contends that because this reference teaches an alkyl amine dodecylbenzenesulfonate, it would therefore be obvious to employ the claimed isopropyl amine salt of dodecylbenzene sulfonic acid. Applicant respectfully disagrees with the Examiner's conclusion of obviousness for the following reason.

The requisite motivation for the routineer to wish to employ the claimed isopropyl amine salt of dodecylbenzene sulfonic acid is still believed by Applicant to be lacking. The numb r of alkyl amine dodecylbenzenesulfonate compounds which fall within the definition

of this compound are numerous indeed. To believe that the routineer would wish to choose the claimed isopropyl amine salt of dodecylbenzene sulfonic acid, rather than any of the other numerous candidates which similarly qualify, is believed by Applicant to be an example of an improper "obvious to try" rationale. This being the case, Applicant would like to note that it is well settled that where the prior art gives either no indication as to which parameters are critical or no direction as to which of many possible choices is likely to be successful, prima facie obviousness may not be based on an improper "obvious to try" rationale. See, In re O'Farrell, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

The same reasoning holds true for claim 43 and its use of a propylene glycol n-butyl ether short-chain cosurfactant.

Finally, Applicant respectfully submits that this reference's teaching must be read in light of the fact that its composition is directed to cleaning **textiles**, whereas the claimed composition is intended to be used for cleaning hard surfaces. The amount and type of surfactants used in a textile cleaning composition typically differ from those employed in hard surface cleaning compositions. It cannot be presumed that they are interchangeable and therefore, prima facie obvious. This too will have an effect on the routineer's motivation as to which type of components to employ in the Steven's composition.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is again respectfully requested.

Claims 49-50 remain rejected are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevens '031 as applied to claims 33, 34, 36-42 and 44-48 above, and further in view of Van Eenam (US 5,585,341). This rejection is again respectfully traversed for the following reasons.

The Examiner contends that Stevens teaches the invention substantially as claimed with the exception of cyclic ketone, specifically cyclohexanone. In an effort to overcome this particular lack of teaching or suggestion, the Examiner relies upon the '341 reference

for its alleged teaching regarding the use of cyclohexanone as an organic solvent in hard surface cleaners/degreasers.

In response thereto, Applicant would again like to note that as has been shown above, Stevens fails to contain any teaching or suggestion regarding the use of the claimed weight percents of each of Applicant's specifically claimed surfactants. Therefore, even if these two references were combined, as is suggested by the Examiner, they would nevertheless fail to render the claimed invention prima facie obvious. Accordingly, for the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 53-54 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevens '031 as applied to claims 33, 34, 36-42 and 44-48 above, and further in view of Cilley et al (US 6,180,583). This rejection is again respectfully traversed for the following reasons.

The Examiner contends that Stevens teaches the invention substantially as claimed with the exception of a thickening agent such as bentonite. In an effort to overcome this particular lack of teaching or suggestion, the Examiner relies upon the '583 reference for its alleged teaching regarding the use of thickeners in hard surface cleaners/degreasers.

In response thereto, Applicant would again like to note that as has been argued on numerous occasions above, Stevens fails to contain any teaching or suggestion regarding the use of the claimed weight percents of each of Applicant's specifically claimed surfactants. Therefore, even if these two references were combined, as is suggested by the Examiner, they would nevertheless fail to render the claimed invention prima facie obvious.

Serial No.: 09/643,141
Art Unit: 1746

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Respectfully submitted,

Steven J. Trzaska
(Reg. No. 36,296)
Attorney For Applicant(s)
(610) 278-4929

Cognis Corporation
2500 Renaissance Blvd., St. 200
Gulph Mills, PA 19406

SJT/mc G:\DATA\TRZASKA\M5636-116res.DOC

EXPEDITED PROCEDURE - AMENDMENT AFTER FINAL

TELECOPY

COGNIS CORPORATION
2500 RENAISSANCE BLVD., SUITE 200
GULPH MILLS, PA 19406
USA

DATE: April 3, 2003

TO:
Name: Examiner S. Carrillo, USPTO
Art Unit 1746
Fax No.: 703-872-9311

FROM:
Name: S. Trzaska, Gulph Mills, PA
Fax No.: 610-278-4971

NUMBER OF PAGES 8 INCLUDING THIS COVER PAGE.

We are transmitting from facsimile machine 610-278-4971.

If you do not receive all the pages indicated above, please call Marlene Capreri at (610) 278-4924 or 610-278-4920 between 8:00 A.M. and 5:00 P.M.

Re: Serial No. 09/643,141 filed 08/22/00
Attorney's Docket: M 6636 CC/CSAP

- Response Under Rule 116 (7 pages)